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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,706	02/05/2002	Michael John Curry	1049.001US1	6456
23441 7590 05/29/2008 LAW OFFICES OF MICHAEL DRYJA 1474 N COOPER RD #105-248 GILBERT, AZ 85233				
EXAMINER				
NGUYEN, VAN H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/683,706

Applicant(s)

CURRY ET AL.

Examiner

VAN H. NGUYEN

Art Unit

2194

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment filed 02/27/2008.

Claims 1-20 are currently pending in this application. Claims 1, 12, and 19 are independent claims.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claim 1, the claim recites a “system” comprising “an operating system”, “an application program”, and “an audio or video program”. As currently recited the “system” comprises only computer software elements. Thus, the claim is a program per se and does not fall within any of the four enumerated categories of patentable subject matter in section 101.

Dependent claims 2-11 are rejected for fully incorporating the deficiencies of their base claims.

Regarding independent claim 12, the method claim differs from traditional process claims in several respects. For example, the claim does not recite any particular way of implementing the step, nor does it require any machine or apparatus to perform the step. In addition, the method claim does not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claim does not call for any physical transformation of an article to a different state or thing. While claim 12 performs “*detecting*”, it does not require any machine or apparatus to perform the step. Because the claim is completely untethered from any sort of structure or physical step, it is directed to a disembodied concept. In other words, the claim is nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be limited to a practical application of the idea. For example, claim 12 does not specify whether the entity performing the step of “*detecting*” is a computer, a human, or something else. Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than a practical implementation of the concept.

For the same reasons discussed *supra* with respect to independent claim 12, dependent claims 13-18 fall outside the scope of § 101.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Helferich et al.**
(US 6826407 B1).

As to claim 1:

Helferich teaches (*see the title; abstract; col.3, line 19-col.4, line 6; see also, the discussion beginning at col.4, line 46*) a system (*a communication system for integrating audio and visual messaging*) comprising:

an operating system (*operating system*);

an application program running on the operating system; and, an audio or video program running on the operating system, the audio or video program separate from but integrated with the application program such that the application program is unaware that the audio or video program has been integrated therewith, such that a user of the application program interacts with the audio or video program as though the audio or video program were part of the application program (*a communication system for*

integrating audio and visual messaging. The communication system includes a communication device for receiving visual messages and for transmitting voice messages to a recipient, and an integrated mail gateway for receiving from the communication device a voice message and addressing information. The integrated mail gateway is programmed to create an electronic mail (hereinafter "e-mail") message comprising the voice message. The integrated mail gateway is also programmed to use the addressing information to address the e-mail message, and to send the addressed e-mail message to the recipient...the communication system is used by a user of a communication device to send a voice message in reply to a received visual message...The IMG records and stores the voice reply message. Optionally, the IMG will format the voice reply message into a conventional audio file format. The IMG then creates an e-mail message and includes the voice reply message in the e-mail).

As to claim 2:

Helferich teaches the audio or video program is integrated with the application program by detecting when an event related to the application program occurs (*see Figs. 7-8 and the associated text*).

As to claim 3:

Helferich teaches the audio or video program is further integrated with the application program by subclassing into a window of the application program (*see Figs. 7-8 and the*

associated text).

As to claim 4:

Helferich teaches the audio or video program is further integrated with the application program by hooking into a window of the application program (*see Figs. 7-8 and the associated text*).

As to claim 5:

Helferich teaches the audio or video program is integrated with the application program by employing a customization mechanism of the application program (*see Figs. 7-8 and the associated text*).

As to claim 6:

Helferich teaches the audio or video program is integrated with the application program by employing application programming interfaces of the application program (*see Figs. 7-8 and the associated text*).

As to claim 7:

Helferich teaches the audio or video program modifies contents of a window of the application program created through the operating system (*see Figs. 7-8 and the associated text*).

As to claim 8:

Helferich teaches the audio or video program runs in a window created through the operating system and related to a window of the application program created through the operating system (*see Figs.7-8 and the associated text*).

As to claim 9:

Helferich teaches the application program comprises, among other things, an email program (*programmed to create an e-mail message/ email-software; col.3, line 19-col.4, line 6; see also, the discussion beginning at col.4, line 46*).

As to claim 10:

Helferich teaches the audio or video program comprises, among other things, an audio player program (*see Figs.7-8 and the associated text*).

As to claim 11:

Helferich teaches the audio or video program comprises, among other things, an audio-only program (*see Figs.7-8 and the associated text*).

As to claim 12:

Helferich teaches a method (*see the title; abstract; col.3, line 19-col.4, line 6;Figs. 1-9; see also, the discussion beginning at col.4, line 46*) comprising: detecting when an event

related to a predetermined application program occurs; in response to detecting when the event has occurred, an audio or video program presenting one or more audio or video controls for use in conjunction with the predetermined application program, such that the audio or video program encompassing the one or more audio or video controls is integrated with the predetermined application program, the audio or video program being separate from the predetermined application program (*a communication system for integrating audio and visual messaging. The communication system includes a communication device for receiving visual messages and for transmitting voice messages to a recipient, and an integrated mail gateway for receiving from the communication device a voice message and addressing information. The integrated mail gateway is programmed to create an electronic mail (hereinafter "e-mail") message comprising the voice message. The integrated mail gateway is also programmed to use the addressing information to address the e-mail message, and to send the addressed e-mail message to the recipient...the communication system is used by a user of a communication device to send a voice message in reply to a received visual message...The IMG records and stores the voice reply message. Optionally, the IMG will format the voice reply message into a conventional audio file format. The IMG then creates an e-mail message and includes the voice reply message in the e-mail).*

As to claim 13:

Helferich teaches presenting the one or more audio or video controls comprises integrating the one or more audio or video controls within a window of the predetermined

application program (*see Figs.7-8 and the associated text*).

As to claim 14:

Helferich teaches presenting the one or more audio or video controls comprises creating an audio or video program window through an operating system in which the one or more audio or video controls are located (*see Figs.7-8 and the associated text*).

As to claims 15-18:

Note the rejection of claims 3-6 supra. Claims 15-18 are the same as claims 3-6, except claims 15-18 are method claims and claims 3-6 are system claims.

As to claim 19:

Note the rejection of claim 12 supra. Claim 19 is the same as claim 12, except claim 19 is a computer-readable medium claim and claim 12 is a method claim.

As to claim 20:

Helferich teaches the predetermined application program, among other things, an email program (*programmed to create an e-mail message/ email-software; col.3, line 19-col.4, line 6; see also, the discussion beginning at col.4, line 46*).

Response to Arguments

4. Applicant's arguments filed 02/27/2008 have been fully considered but they are not persuasive.

Applicant argued in substance that "*Claim 1 is limited to a system including an "operating system." Applicant can find no indication of an "operating system" in Helferich... Claim 1 is limited to "a user of the application program interact[ing] with the audio or video program as though the audio or video program were part of the application program." Applicant has review Helferich in detail in relation to this limitation as well, and can find no semblance of disclosure in Helferich that corresponds to this limitation of claim 1*" (Remarks; pp.7-9).

The examiner's response is as follows. Firstly, in the Office Action, the examiner mapped each claimed limitation to specific element(s) and/or relevant passages in the Helferich reference to show how the reference meets the claim limitations. Applicant in response did not provide any underlying analysis as to why the portions of the prior art relied on did not support the examiner's position. Secondly, Applicant simply points out what is broadly recited in the claim and asserts that "*Applicant can find no indication of an "operating system"... Applicant has review Helferich in detail in relation to this limitation as well, and can find no semblance of disclosure in Helferich that corresponds to this limitation of claim 1*". This quote is the extent of explanation provided by

Applicant in support of claim 1. This response by Applicant is insufficient to satisfy the requirement of specific argument to have the claims considered for patentability; in accordance with 37 C.F.R. § 1.111 *Applicant must distinctly and specifically point out "how the language of the claims patentably distinguishes them from the references"*.

Every computer must have an operating system to run other programs. Helferich system must have an operating system (see col.8, line 1) to run email and audio programs.

With respect to independent claims 12 and 19, Applicant simply points out what is broadly recited in each of the claims and asserts that "Applicant has reviewed Helferich in detail, and can find no semblance of disclosure in Helferich that corresponds to these limitations of claim 12". Again, this response by Applicant is insufficient to satisfy the requirement of specific argument to have the claims considered for patentability; in accordance with 37 C.F.R. § 1.111 *Applicant must distinctly and specifically point out "how the language of the claims patentably distinguishes them from the references"*.

Contact Information

4. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM

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6:00PM. The examiner can also be reached on alternative Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MENG-AI AN THOMSON can be reached at (571) 272-3756.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VAN H NGUYEN/

Primary Examiner, Art Unit 2194